PATENT
Docket No. 56077US002
(formerly 56077USA7A.002)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant(s):	C.V. ANDERSON et al.	Group Art Unit:	1734
Serial No.:	09/759,993	Examiner:	Mark A. Osele
Confirmation No.:	1053		
Filed:	12 January 2001		
For:	ADHESIVE FILM REMOVAL METHOD AND APPARATUS		

REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)(1)

Assistant Commissioner for Patents
Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants present this Reply Brief in response to the Examiner's Answer dated 30 September 2003 and in support of the appeal from the final rejections of claims 1, 4, 5, 8-13, 17, 18, and 21-25 in the above-identified patent application as indicated in the Notice of Appeal filed 29 April 2003. Appellants furthermore incorporate by reference herein the Appeal Brief dated 28 August 2003.

Reply to Examiner's Arguments

I. **Claims 1, 4, 8-13, 17, 21, 22, and 25 are patentable over French Patent Publication No. 2643847 to Apollonio et al. under 35 U.S.C. § 102(b).**

The Examiner provides, beginning at page 5 of the Answer, what is asserted to be a detailed analysis of where each claimed element may be found in Apollonio et al. and Kuroda et al. With respect to the former, the Examiner asserts that the framework of Apollonio et al. "pivotally connects the winding reel 24, with rollers, 34, which ride along the surface of the

structure, 20. . . The tension of the film, 32, winding on the spaced apart reel 24, will pivot the framework of Apollonio et al., pressing the rollers, 34, against the structure thereby transferring the tension from the film onto the structure itself." *Examiner's Answer*, page 5, emphasis added. Appellants traverse these assertions for at least the following reasons.

The Examiner has not identified any teaching within Apollonio et al. that describes pivoting of the reel 24 or the roller 34 as asserted. That is, there is no teaching identified that the framework of Apollonio et al. pivots so that the roller 34 transfers tension from the film to the structure. In fact, the structure supporting the reel and roller (carriage reel stand 3) in Apollonio et al. is described as being coupled to the pole 1 by four rollers 6 and 7. "The rollers 6 are pressed against the higher face [of the pole 1], while the rollers 7 roll on the lower face." Page 3, third paragraph. As a result, any forces that would tend to pivot the support structure 3 of Apollonio et al. are reacted through the rollers 6 and 7, i.e., there is no indication that pivoting of the stand 3 can even occur or, if it did, that it would result in load transference from the film to the roller 34.

The Examiner's Answer thus fails to provide a reasoned technical analysis that would support an anticipation rejection explicitly or based on inherency. Rather, it provides only additional conclusory statements in support of the rejection that attempt to characterize Apollonio et al. in a manner that is not supported by the document itself. Moreover, in support of the rejection, the Answer further tries to draw parallels to elements that are not even claimed, see, e.g., *Examiner's* Answer, page 7, regarding frame supports.

In view of the above, Appellants submit that the Office has not met its burden in establishing inherency of the claimed subject matter in Apollonio et al. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

II. Claims 1, 5, 8-10, 12, 18, 21-22, and 25 are patentable over U.S. Patent No. 5,891,298 to Kuroda et al. under 35 U.S.C. § 102(b).

The Examiner's Answer asserts that Kuroda et al. "shows analogous structures to Fig. 4 of the instant invention." *Examiner's Answer*, page 5. Specifically, the Answer states that the

framework of Kuroda et al. "pivotally connects the winding reel, 18, with rollers, 8, which rides along the surface of the structure, W." *Examiner's Answer*, pages 5-6. "The tension of film, 3, winding on spaced apart reel, 18, will pivot the framework of Kuroda et al. pressing the rollers, 8, against the surface of the structure thereby transferring the tension from the film onto the structure itself." *Id.* at page 6. Appellants respectfully disagree.

Kuroda et al. teach an apparatus and methods for peeling protective adhesive tape (3) from a substrate. The peeling is performed by applying a peeling tape (5) to the protective adhesive tape (3) and then peeling both the peeling tape (5) and the protective adhesive tape (3) from the underlying substrate. A first roller (8) applies pressure to the back of the peeling tape (5), while a second roller (6) defines a release line along which the peeling tape (5) and the protective adhesive tape (3) are removed. *See, e.g., Kuroda et al.*, Abstract, Figs. 8 & 13.

Appellants submit that, like the previous rejection under Apollonio et al., the Examiner has failed to identify, explicitly or inherently, the elements of the claimed inventions. For example, there is no teaching identified that the apparatus of Kuroda et al. transfers tension from the film to the workpiece. Rather, the Answer provides only conclusory statements that the framework pivots and, therefore, must inherently function in a manner identical to the apparatus claimed by Appellants.

Appellants first submit that the Examiner has not identified any teaching regarding the asserted relative pivoting in Kuroda et al. Rather, all that Kuroda et al. teaches is that "the applying roller 8 is lowered and biased to the peel starting end 3a." Col. 5, lines 5-6. There is no indication that the biasing is, in any way, related to the tension of the film. That is, there is no indication that the roller 8 applies a load to the substrate in relation to the tension of the film. The biasing force could merely be provided by a spring which applies a downward force (when viewed in Figures 7 and 8).

Without such a teaching, it is unclear how Kuroda et al. can anticipate the rejected claims. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *M.P.E.P.* § 2112, p. 2100-52, 8th Ed., Rev. 1, (Feb. 2003) (emphasis in original) (citing *In re Rijckaert*, 28 USPQ2d 1955,

1957 (Fed. Cir. 1993)). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

In view of all of the above, Appellants submit that the Office has not met its burden in establishing anticipation based on inherency of claims 1, 5, 8-10, 12, 18, 21-22, and 25 by Kuroda et al. Review and reversal of this rejection by the Board are, therefore, respectfully requested.

II. Claims 23 and 24 are patentable over French Patent Publication No. 2643847 to Apollonio et al. under 35 U.S.C. § 103(a).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143.

Appellants submit that claims 23 and 24 are not *prima facie* obvious because, at a minimum, Apollonio et al. does not teach or suggest all of the elements of claims 23 and 24, both of which depend from independent claim 22. As discussed above with respect to the anticipation rejection of claim 22 based on Apollonio et al., the cited reference does not teach all of the limitations of independent claim 22. It is further submitted that Apollonio et al. fails to even suggest the missing elements.

Appellants further submit that no suggestion or motivation has been identified in support of this obviousness rejection that would lead one of ordinary skill in the art to modify the apparatus of Apollonio et al. to reach the invention of claim 22 and, thus, claims 23 and 24. Moreover, claims 23 and 24 recite additional features that further define the patentability of the invention recited in claim 22.

For these reasons, Appellants respectfully request review and reversal by the Board of the rejection of claims 23 and 24.

SUMMARY

In summary, the Examiner's assertions that the inventions of Apollonio et al. and Kuroda et al. "have parallel structures to the apparatus of the instant invention" (*Examiner's Answer,* page 6) are unsupported. For example, there is no identification of a pivot axis such as the axis 132 illustrated in Figure 4 of the instant application. As a result, the Examiner has failed to identify all claim elements, e.g., transferring the film tension onto the substrate, and therefore, cannot establish anticipation.

It is respectfully submitted that all of pending claims 1, 4-13, and 17-25 are patentable. It is earnestly requested that the Board reverse the Examiner's rejections of claims 1, 4, 5, 8-13, 17, 18, and 21-25, and that all of the claims be allowed.

Respectfully submitted for

Conrad V. ANDERSON et al.

By
Mueting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415
Phone: (612) 305-1220
Facsimile: (612) 305-1228

26 NOV. 2003
Date

By: KWR
Kevin W. Raasch
Reg. No. 35,651
Direct Dial (612)305-1218

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, **Mail Stop Appeal Brief – Patents**, P.O. Box 1450, Alexandria, VA 22313-1450.
By: Rachel Caglioti-Gebhardt
Name: Rachel Caglioti-Gebhardt